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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,111

12/09/2005

Harlan A. Hurwitz

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OLIFF & BERRIDGE, PLC

P.O. BOX 320850

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EXAMINER

MAGUIRE, LINDSAY M

ART UNIT

PAPER NUMBER

3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,111	<b>Applicant(s)</b> HURWITZ ET AL.	
	<b>Examiner</b> LINDSAY M. MAGUIRE	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-11,13-19 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,13-19 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Non-Final office action is in response to the application filed on December 9, 2005, the response to the Restriction/Election requirement filed on February 26, 2008, the amendments filed on October 8, 2008, and the Request for Continued Examination filed on May 1, 2009.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 1, 2009 has been entered.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 6-11, and 13-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').<sup>7</sup> A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Claims 1-4, 6-11, and 13-17 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, claims 1-4, 6-11, and 13-17 are non-statutory under § 101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 13-19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,014,649 (Kobayashi et al. '649), In view of U.S. PGPb. No. 2002/0111886 (Chenevich et al. '886).

**Re Claim 1:** Kobayashi et al. '649 disclose a method/system of electronically managing payment media capacity of a payment media handling apparatus, comprising: receiving a request for a payment media operation (Abstract); and wherein a request for a payment media operation is made by an entity including one of at least a till, a bank, a CIT operator and a supervisor (abstract; i.e. cash). Further, Kobayashi et al. '649 disclose that the payment media pickup redirect action and the payment media deposit redirect action direct the operator to another cash handling apparatus to complete the payment media operation (column 5, line 32 - column 6, line 65).

Kobayashi et al. '649 does not explicitly state automatically determining the possibility of performing the requested payment media operation by comparing information provided in the payment media operation request to information including determining the payment media in the payment media handling apparatus; and performing a payment media action based on a result obtained from the automatic determination of the possibility of performing the requested payment media operation (abstract), and wherein the payment media operation includes at least one of a payment media acceptance operation, a start fund operation, a payment media change

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dispensing operation, a payment media advance operation and a bank deposit operation (abstract). It is considered to be old and well known in the art of automatic teller machines (ATMs) to verify if there are funds available in the account associated with the payment media (i.e. card) that is inserted into the machine, and that once that has been determined, to accept the operation, and to either provide the requested funds or to allow the deposit of funds into the account. Further, Kobayashi et al. '649 does not explicitly require that the step of performing a payment media action runs parallel to the performance of other payment media actions. However, Chenevich et al. '886 disclose a payment manager that may be part of a market place (i.e. being used by multiple people at the same time; paragraphs [0008 & 0041]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kobayashi et al. '649, in view of the teachings of Chenevich et al. '886, for the basic reason of allowing more than one person to use the system at once, or for multiple media actions to be performed at once (Kobayashi et al. '649: column 34, lines 1-11).

**Re Claim 2:** Kobayashi et al. '649 discloses the method/system substantially as claimed, as advanced above, including wherein the request for the payment media operation is automatically provided by a controller in response to instructions stored on a machine-readable storage medium (column 11, line 42 – column 12, line 54).

**Re Claim 3:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including wherein the request for the payment media operation is provided by an operator (column 11, line 42 – column 12, line 54).

**Re Claim 4:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, with the exception of requiring that the payment media handling apparatus manages the payment media operation for one or more retail stores having one or more payment media originating sources. However, Chenevich et al. '886 disclose a system that manages payment media operations that can occur in multiple places, i.e. for one or more retail stores, having one or more origination sources (paragraph [0061]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kobayashi et al. '649, in view of the teachings of Chenevich et al. '886, for the basic reason of providing a complete, linked system.

**Re Claim 6:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including that the step of determining the possibility of performing the requested payment media operation includes at least a determination of a payment media capacity of the payment media handling apparatus (abstract; column 6, lines 38-46).

**Re Claim 7:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including that the determination of a payment media capacity of the payment media handling apparatus is performed using one of a physical measuring device and a payment media accounting technique (column 23, line 23 – column 24, line 10).

**Re Claim 8:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including a payment media stack height measuring device (Figure 20).

**Re Claim 9:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including wherein the payment media action further comprises at least one of the payment media operation, an annunciation action, and a payment media pickup request action, and a payment media delivery request action (abstract).

**Re Claim 10:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, with the exception of requiring that the annunciation action informs a supervisory entity in the retail store of the result obtained from the automatic determination of the possibility of performing the requested payment media operation. However, Kobayashi et al. '649 does disclose a clerk that monitors, "information necessary for close examination" as well as a display screen and a print



out. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the system to include informing a supervisor (i.e. clerk) of the result of the automatic determination of the possibility to perform the requested media operation, for the basic reason of alerting the clerk to any problems that may have or will occur.

**Re Claim 11:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including that the payment media pickup request action and payment media delivery request action are provided to at least one of a banking entity or a cash-in-transit operator (column 1, lines 5-9).

**Re Claim 13:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including that the step of automatically determining the possibility of performing the requested payment media operation is performed based on at least one of a group of rules stored in a lookup table, instructions provided for a retail store, and instructions provided by an entity other than a retail store, wherein a retail store includes one or more of at least a single store, multiple stores, one or more third party concession stands located within a single store and two or more stores located within a mall (column 5, line 32 – column 6, line 65). Chenevich et al. '2002 disclose that there are rules associated with a payment operation (in at least paragraphs [0008-0011, 0048, 0049, 0051]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that this device could be used in a retail

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environment and with a set of rules, in order to insure that there is a constant supply of money in the tills.

**Re Claim 14:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, with the exception of requiring that the group of rules includes a consideration of at least one of retailer type, retailer size, retailer location, the specific cash accepting device requesting the payment media action, time of day for the payment media action, calendar date for the payment media action, calendar date of national or local holidays, calendar date of scheduled festivities or organized events, and a retail store scheduled sales event. However, Kobayashi et al. '649 disclose that the payment media devices are monitored in real time, and therefore if it were a holiday, and more cash was needed at a quicker pace, then obviously the device would respond accordingly (column 5, line 32 - column 6, line 65).

**Re Claim 15:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, with the exception of requiring that the payment media activity information comprises electronic point of sale (EPOS) data, payment media refund amount information, frequency and size of cash refunds processed within a predetermined period of time, dispensed payment media information or received payment media information from an automatic teller machine located in a retail store, a value, type and denomination of payment media available to effect the particular payment media operation, and payment media pickup or delivery information scheduled

by a cash-in-transit operator. However, Kobayashi et al. '649 does disclose a clerk that monitors, "information necessary for close examination" as well as a display screen and a print out. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for system to include the aforementioned information for the basic reason of tracking the amount of money going through the terminal.

**Re Claim 16:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, with the exception of requiring that the instructions provided by the entity other than a retail store are provided to a retail store via a communication network. However, Chenevich et al. '886 discloses that all of the players involved in the payment media process are connected through a network (see Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kobayashi et al. '649, in view of the teachings of Chenevich et al. '886, for the basic reason of insuring that all involved in the payment media process know what is going on.

**Re Claim 17:** Kobayashi et al. '649 disclose the method/system substantially as claimed, as advanced above, including that the step of performing the payment media action requires no additional input from the operator other than the request for the payment media operation (see Figure 21).

**Re Claims 18, 19, and 24:** Claims 18, 19, and 24 are substantially similar to the claims, as advanced above, and are therefore rejected using the same art, under the same rationale. Arguments to the contrary should include applicant's reasoning why they are not substantially similar, yet are similar enough as to not incur a restriction requirement.

### ***Response to Arguments***

Applicant's arguments filed May 1, 2009 have been fully considered but they are not persuasive.

Applicant's arguments that the references do not show either a payment media pickup redirect action or a payment media deposit redirect action, have been considered, however the examiner is of another opinion. Specifically, Kobayashi et al. '649 discloses:

"The periodical replenishment/collection function allows the control section 4 to constantly manage the number of bills currently being stored in each ATM 1, to periodically estimate the demanded number of bills in each ATM 1 on the basis of changes in the number of bills in each ATM 1, and to control the bill replenishment/collection operation performed by the mobile cart 2 in accordance with the demanded number of bills such that the numbers of bills in the ATMs 1 are balanced." (column 6, lines 38-46).

It can be clearly shown from this excerpt of Kobayashi et al. '649 that there is a deposit action and a redirect action, e.g. if an ATM is determined to have enough bills then it is directed or redirected to another ATM that is in need of bills, or has too many bills. Therefore, Kobayashi et al. '649 is considered to fully meet the aforementioned limitations of the claim, as advanced above.

### ***Conclusion***

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lindsay M. Maguire  
5/21/09  
/Lindsay M Maguire/  
Examiner, Art Unit 3692

/Kambiz Abdi/  
Supervisory Patent Examiner,  
Art Unit 3692